

REMARKS

Claims 1-14 are currently pending, wherein claim 1 has been amended to correct a typographical error. Applicants respectfully request favorable reconsideration in view of the remarks presented herein below.

At the outset, Applicants note with appreciation the indication that claim 4 has been allowed and that claims 3-7 contain allowable subject matter.

In paragraph 3 of the Office Action ("Action"), the Examiner rejects claims 1, 8, and 11-14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,185,360 to Inoue et al. ("Inoue") in view of the admitted prior art ("APA") discussed on pages 1-3 of the specification. Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some motivation to modify/combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1, 8, and 11-14 are not rendered unpatentable by the combination of Inoue and the APA because the Examiner fails to establish a *prima facie* case of obviousness as discussed below.

With regard to the motivation to combine Inoue with the APA, the Examiner asserts that it would have been obvious to one skilled in the art to modify "Inoue with the

admitted prior art by providing [the] Inoue apparatus with a control means as taught by the admitted prior art for detecting a connection of the power source with an external power source thereby enhancing the capacity of the Inoue apparatus for further controlling the receiver." This assertion is unfounded for the following reasons.

First, the mere fact that references can be combined is not sufficient in and of itself to render the resultant combination obvious, absent some evidence of the desirability of the modification. Nowhere in the cited references, or the Action, is there any evidence or suggestion of the desirability of detecting the connection of an power source plug to an external power source. Clearly, the Examiner's allegedly motivation for the combination of Inoue and the APA is improperly based on hindsight reconstruction.

Second, nowhere in the APA is there any disclosure or suggestion of detecting means for detecting the connection of a power source plug to an external power source, much less that the addition of such a detecting means would enhance the capacity of the Inoue apparatus to control the receiver. Accordingly, absent proper motivation to combine Inoue and the APA, the rejection of claims 1, 8, and 11-14 is improper.

Furthermore, even if one skilled in the art were motivated to combine Inoue and the APA, the combination would still fail to render claims 1, 8, and 11-14 unpatentable because the combination fails to disclose each and every claimed element as discussed below.

Independent claim 1 defines a signal receiver for displaying received broadcast electric waves. The signal receiver includes, *inter alia*, a first memory for storing, as a past record, information representing whether the signal receiver was previously subjected to an initial setup, and an alarm device for alarming the necessity of the initial setup of the signal receiver, which is activated by a processing device, when a connection of a power source plug to an external power source is detected by said processing device and no past record exists in the first memory, whereby a user performs the initial setup using a guided setup which is initiated in response to the alarm device and/or an activation device being activated.

Inoue discloses an information receiving apparatus and method for automatically recording reserved programs when the recording time of the reserved programs overlap. According to the method of Inoue, the system determines or judges which of the overlapping programs is to be recorded based on additional program information. However, nowhere in Inoue is there any disclosure or suggestion of a first memory for storing, as a past record, information representing whether the signal receiver was previously subjected to initial setup, or of an alarm device for alarming the necessity of the initial setup as claimed.

In rejecting claim 1, the Examiner asserts that Inoue discloses a first memory as claimed inasmuch as Inoue discloses storing as reserved programs, programs which are to be recorded. However, nowhere in Inoue is there any disclosure or suggestion of

storing information regarding whether or not the receiver has been subjected to an initial setup. At best, Inoue merely discloses memory for storing program information.

In addition, the Examiner asserts that the APA discloses means for detecting a connection of a power source. This assertion is completely unfounded. Nowhere in the specification or FIG. 2 is there any disclosure or suggestion that the prior art receivers include means for detecting a connection of a power source as asserted by the Examiner.

Since Inoue and the APA both fail to disclose or suggest a signal receiver that includes a first memory and an alarm device as claimed, the combination of these two references cannot possibly disclose or suggest said elements. Therefore, even if one skilled in the art were motivated to combine Inoue and the APA, which Applicants do not concede, the combination would still fail to render claim 1 unpatentable because the combination fails to disclose each and every claimed element.

Independent claim 8 defines an electronic receiver having a plurality of programmable initial settings. The receiver includes, *inter alia*, a processing device for detecting the connection of a power source plug to an external power source, a controller for detecting whether the initial settings are programmed into the electronic receiver, which is activated by the processing device, an alarm, responsive to the controller, for notifying a user that the initial settings are not programmed into the receiver, an activation device operatively associated with the alarm, and a guided menu for programming the initial settings into the receiver, when the user responds to the

alarm and the activation device. In addition, independent claim 14 defines a method for programming an electronic receiver having a plurality of initial settings. The method includes, *inter alia*, detecting whether the initial settings are programmed into the electronic receiver, warning a user that the initial settings are not programmed into the electronic receiver, providing a user input device to be activated in response to the warning, and providing a guided menu for programming the initial settings into the electronic receiver, when the user responds to the warning and activates the input device.

Accordingly, independent claims 8 and 14 are patentable over the combination of Inoue and the APA for at least the reason that the combination fails to disclose each and every claimed element. More specifically, Inoue and the APA both fail to disclose or suggest an alarm and activation device as claimed. (See discussion above with respect to claim 1.)

Claim 13 depends from independent claim 8. Therefore, claim 13 is patentable over the combination of Inoue and the APA for at least those reasons presented above with respect to claim 8. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 8, 13, and 14 under 35 U.S.C. § 103.

In paragraph 4 of the Action, the Examiner rejects claims 2 and 9 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of Inoue and the APA, further in view of U.S. Patent No. 6,370,317 to Nagano et al. ("Nagano"). Applicants respectfully traverse this rejection.

Claims 2 and 9 depend from claims 1 and 8, respectively. Accordingly, claims 2 and 9 are patentable over the combination of Inoue and the APA for at least those reasons presented above with respect to claims 1 and 8.

Nagano discloses an apparatus and method for controlling the recording of television programs. However, Nagano fails to overcome the deficiencies of Inoue and the APA. Therefore, since Inoue, the APA, and Nagano each fail to disclose or suggest a signal receiver that includes a first memory or an alarm as claimed, the combination of these three references cannot possibly disclose or suggest said elements. Therefore, even if one skilled in the art were motivated to combine Inoue, the APA, and Nagano, which Applicants do not concede, the combination would still fail to render claims 2 and 9 unpatentable because the combination fails to disclose each and every claimed element. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2 and 9 under 35 U.S.C. § 103(a).

In paragraph 5 of the Action, the Examiner rejects claim 10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of Inoue, the APA, and Nagano, further in view of U.S. Patent No. 5,517,321 to Yoshida ("Yoshida"). Applicants respectfully traverse this rejection.

Claim 10 depends from claim 9. Accordingly, claim 10 is patentable over the combination of Inoue, the APA, and Nagano for at least those reasons presented above with respect to claim 9.

Yoshida discloses a video tape recorder that measures the time remaining on a tape and compares it with the time programmed for a timer recording. However, Yoshida fails to overcome the deficiencies of Inoue, the APA, and Nagano. Therefore, since Inoue, the APA, Nagano, and Yoshida each fail to disclose or suggest a signal receiver that includes a first memory or an alarm as claimed, the combination of these four references cannot possibly disclose or suggest said elements. Therefore, even if one skilled in the art were motivated to combine Inoue, the APA, Nagano, and Yoshida, which Applicants do not concede, the combination would still fail to render claim 10 unpatentable because the combination fails to disclose each and every claimed element. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 10 under 35 U.S.C. § 103(a).

The application is in condition for allowance. Notice of same is earnestly solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny Caudle (Reg. No. 46,607) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees.

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Respectfully submitted,

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